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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/725,296 | 12/01/2003 | James D. Ralph | F-301 | 2843 |
| 36402 | 7590 | 05/24/2004 | EXAMINER | |
| SPINECORE, INC. 447 SPRINGFIELD AVENUE SUITES W2-W3 SUMMIT, NJ 07901 | | | BLANCO, JAVIER G | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3738 | |

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,296

Applicant(s)

RALPH ET AL.

Examiner

Javier G. Blanco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

1. The Oath/Declaration is objected to because the title of the invention (i.e., “An intervertebral spacer device having a domed arch shaped spring”) does not match the title of the invention according to the Bib Data Sheet (i.e., “Intervertebral spacer device having a domed arch shaped spring”). Correction is required.

Specification

2. The disclosure is objected to because of the following informality: please update the CROSS REFERENCE TO RELATED APPLICATIONS section (i.e., now US 6,673,113, or, now abandoned). Also, it seems the title of the invention should read “Intervertebral spacer device having a domed arch shaped spring”. Appropriate correction is required.

Claim Objections

3. Claims 1 and 4 are objected to because of the following informalities:

a. Regarding claim 1, please add --domed arch strip spring-- in front of “restoring force” (see line 8). Appropriate correction is required.

b. Regarding claim 4, please add --structure-- after “post” (see line 1). Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,610,092 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 1-7 of this application and claims 1-7 of US 6,610,092 B2 lies in the fact that the patent claims include many more elements and is thus much more specific. Thus the invention of claims 1-7 of US 6,610,092 B2 is in effect a "species" of the "generic" invention of claims 1-7 of this application. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 1-7 of the application are anticipated by claims 1-7 of US 6,610,092 B2, it is not patentably distinct from claims 1-7 of US 6,610,092 B2.

6. Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,669,731 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 1-7 of this application and claims 1-7 of US 6,669,731 B2 lies in the

fact that the patent claims include many more elements and is thus much more specific. Thus the invention of claims 1-7 of US 6,669,731 B2 is in effect a “species” of the “generic” invention of claims 1-7 of this application. It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 1-7 of the application are anticipated by claims 1-7 of US 6,669,731 B2, it is not patentably distinct from claims 1-7 of US 6,669,731 B2.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Cauthen (US 6,179,874 B1).

As seen in Figures 10A, 10B, 11A, and 11B, Cauthen discloses an intervertebral spacer device (implant 10) comprising first (first element 20) and second (second element 22) plate members and at least one domed arch strip spring restoring force providing element (articulating means 24) disposed between the first and second plate members, and disposed such that a compressive load applied to the external faces of said plates is counteracted by said at least one restoring force providing element (see column 5, lines 29-47; see entire document). The

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articulation surface(s) are either fabricated, or, coated from different materials, including polymeric materials (see column 5, lines 33-39).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ralph et al. (US 5,989,291 A) in view of Cauthen (US 6,179,874 B1).

As seen in Figures 6-9, Ralph et al. disclose the claimed structure of an intervertebral spacer device comprising first and second plate members, and at least one arch-shaped spring element (see also entire document; see claims 1 and 7-10). Although Ralph et al. disclose: "the internal structure of the present invention comprises a spring member, or other equivalent subassembly which provides a restoring force when compressed" (see column 3, lines 26-29), they did not disclose the spring element as a domed arch strip spring element.

However, Cauthen disclose an intervertebral spacer device (see 102(e) rejection above) comprising at least one domed arch strip spring element in order to provide flexibility and resistance both to torsion and to bending of the intervertebral spacer device (see entire document). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teaching of an intervertebral spacer device comprising at least one domed arch strip spring element, as taught by Cauthen, with the

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intervertebral spacer device of Ralph et al., in order to provide flexibility and resistance both to torsion and to bending of the intervertebral spacer device.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Harrington (US 5,893,889 A).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 703-605-4259. The examiner can normally be reached on M-F (7:30 a.m.-4:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB



May 14, 2004



CORRINE McDERMOTT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700